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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
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LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
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MAY 14 2004

OFFICE OF PETITIONS

In re Application of :
Raghavan, et al. : DECISION REFUSING STATUS
Application No. 10/666,532 : UNDER 37 CFR 1.47(b)
Filed: September 19, 2003 :
Atty. Dkt. No.: B-3996NP621226-5 :
For: SYMMETRIC PLANAR INDUCTOR :
:

This decision is in response to the petition under 37 CFR 1.47(b), filed February 20, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor(s). Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed September 19, 2003 without an executed oath or declaration and naming Gopal Raghavan and Michael G. Case as joint inventors. Accordingly, a Notice to File Missing Parts of Nonprovisional Application was mailed December 15, 2003. The Notice required, *inter alia*, an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

The instant petition lacks requirements (1), (2), and (6) set forth above.

As to item (1), petitioner has failed to establish that the inventors received the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the oath or declaration. The documents accompanying the petition indicate that the inventors were sent a declaration/power of attorney and that no responses were received.

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a bona fide effort has been made to present a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventors.

Petitioner has presented no evidence that the non-signing inventors were ever presented with a complete copy of the application papers (specification, claims, drawings, oath or declaration) for the instant application.

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventors were sent a complete copy of the application papers and thereafter refused to execute the declaration. A copy of the application papers should be sent to the last known address of the non-signing inventors, or, if the non-signing inventors are represented by counsel, to the address of the non-signing inventors' attorney. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventors receive the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

As to item (2), an acceptable oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. Petitioner has failed to establish that the person executing the declaration has a sufficient proprietary interest in the application. Accordingly, the declaration submitted herewith has not been properly executed. The declaration should be executed by a corporate officer, such as the president, vice

president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventors. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. The signature block of the non-signing inventor should remain unexecuted. Petitioner's attention is directed to MPEP 409.03(b) for further guidance.

As to item (5), petitioner has failed to sufficiently establish a proprietary interest in the application. Petitioner indicates that proprietary interest lies with HRL Laboratories, LLC. Petitioner has failed to establish that the inventors assigned or agreed to assign the invention to HRL Laboratories. Further, the employment contracts submitted with the instant petition appear to be agreements between Hughes Aircraft Company and the inventors. Moreover, the employment contracts do not indicate that the inventor's have assigned or agreed to assign the invention to HRL Laboratories, LLC or Hughes Aircraft Company.

Any renewed petition must establish that the invention has been assigned to applicant, that the inventor has agreed in writing to assign the invention to applicant, or that applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Petitioner must submit a copy of an employment agreement between the inventor and applicant or a legal memorandum signed by an attorney familiar with the law of the relevant jurisdiction stating that a court of competent jurisdiction would by weight of authority in that jurisdiction award title of the invention to Rule 47 applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306

By hand: Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA 22202

Inquiries related to this decision may be directed to the
undersigned at (703) 305-0310.



Alesia M. Brown
Petitions Attorney
Office of Petitions